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6713-Dr. Wi-ar

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS : HEINRICH GERS-BARLAG ET AL.
SERIAL NO. : 09/265,779
FILED : March 10, 1999
FOR : COSMETIC AND DERMATOLOGICAL LIGHT PROTECTION
FORMULATIONS HAVING A CONTENT OF TRIAZINE
DERIVATIVES AND GLYCERYL COMPOUNDS
ART UNIT : 1614
EXAMINER : R. Cook

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OFFICE OF PETITIONS

September 17, 2001

Hon. Commissioner of Patents
Washington, D.C. 20231

RENEWED PETITION TO WITHDRAW HOLDING OF ABANDONMENT

SIR:

Applicants renew their previous petition to withdraw the holding that this application is abandoned, and, specifically, Applicants request reconsideration of the petition decision dated July 17, 2001.

By way of background, in response to the Office Action dated June 22, 1999, Applicants timely filed a request for a continued prosecution application and a petition for extension of time, but both papers erroneously referred to the parent application, U.S. Serial No. 08/788,147,

instead of the instant application, U.S. Serial No. 09/265,779. In their original petition, Applicants concede the error, but point out that the procedures outlined in *Manual of Patent Examining Procedure* (“MPEP”) § 201.06(d) were not followed before the application was held abandoned. Specifically, the undersigned was not telephoned or contacted in any way to ascertain the correct serial number. Presumably, had the undersigned been telephoned or contacted in some other way, then the correct serial number would have been provided, and the application would not have been held abandoned.

According to page 2 of the decision:

“The Office does make an effort to determine correct Serial No’s where there is a clear error (e.g. transposed digits) in the Serial No. Such is not the fact situation here.”

Pursuant to the offer at the very end of the decision, the undersigned contacted Mr. William R. Dixon, Jr., to gain clarification of this and other points in the decision. According to Mr. Dixon, a clear error might exist where the digits of the serial number were transposed or where the serial number was that of an abandoned application.

In response, Applicants point out that, as conceded in the decision, *the parent was already issued when the CPA papers referring to it were filed*. Thus, in the middle of page 2 of

the decision, there is the acknowledgment that “Serial No. 08/788,147 issued as a patent on October 19, 1999, *two months before* the papers were filed.”

Further, it is also conceded that the CPA papers could not properly relate to Serial No. 08/788,147. Thus, in the middle of page 2 of the decision, there is also the acknowledgment that “[t]he papers filed were likely correlated with the application to which they were directed, namely Serial No. 08/788,147. However, upon correlation such papers would have been considered to be improper [due to the fact that the patent had already issued.]”

Applicants submit that, contrary to the position reached in the decision, these facts would have led a reasonable Patent Office employee to conclude that the serial number on the CPA papers was in error, and such person would have followed the directives in MPEP § 201.06(d) and telephoned the undersigned to determine the true serial number. In this regard, there is no good reason for treating a CPA request relating to an issued patent any different from a CPA request relating to an abandoned application—both requests are clearly improper because prosecution has terminated in the prior application.

The decision states that the error was not clear because the inventorship, title and docket number for Serial No. 08/788,147 is “strikingly similar” to those of Serial No. 09/265,779, but such a state of affairs could hardly be considered to be unusual in cases like these two which are

related as divisional applications.

Further, the decision states that “[h]ad the identifying indicia not been consistent with the mistakenly identified application * * * the Office would have expended some effort to identify the correct application to which the papers should have been directed.” In other words, had Applicants made *more of a mistake*, the holding of abandonment might be withdrawn, but, having made a subtle mistake, the holding of abandonment must stand.

Respectfully, the Patent Office was alerted to the existence of error when it was determined that the CPA papers were filed in connection with a patented file. While Applicants were in error in submitting inaccurate papers, Patent Office personnel were in error if they simply placed these papers in the patented file, as the petition decision suggests was likely done. Applicants submit that a reasonable Patent Office employee would not have simply placed the papers in a patented file, but would have followed the directives in MPEP § 201.06(d) and telephoned the undersigned to determine the true serial number. Accordingly, while Applicants were at fault in submitting papers with the incorrect application serial number on them, the Patent Office was also at fault in not acting on this clear error by following its own published procedures. Therefore, Applicants submit that the original petition decision is in error, and Applicants renew their petition that the holding of abandonment be withdrawn, and that this application be returned to pending status.

Finally, it is noted that the petition decision towards the end contains the admonishment that “this application only contains CPA papers which still have the wrong parent application Serial No. Applicants have made no effort to correct the error in the filed papers.” In response, Applicants point out that this statement is in error since Applicants attempted to correct the problem by bringing the error to the attention of Ms. Renee Pettus, who it was assumed would match the papers to the correct file and make any notation on the papers necessary to reflect the actual serial number. At no time were Applicants requested to submit corrected papers, and, indeed, the MPEP does not suggest or require such. Nevertheless, in order to remove this issue, a corrected CPA request is attached.

In view of the foregoing, Applicants submit that the application did not, in fact, go abandoned. Therefore, Applicants request that the Commissioner withdraw the holding of abandonment and return this application to pending status.

No fee is believed to be due in connection with the consideration of this petition. However, should the Commissioner determine that any fee is, in fact, due, he is hereby authorized to charge such fee to Deposit Account No. 14-1263.